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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/524,710

01/19/2005

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08/06/2008

EXAMINER

GERRITY, STEPHEN FRANCIS

ART UNIT

PAPER NUMBER

3721

MAIL DATE

DELIVERY MODE

08/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/524,710	Applicant(s) MANABE, KATSUNORI	
	Examiner Stephen F. Gerrity	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/27/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 22 May 2008 has been entered.

Information Disclosure Statement

2. Receipt is acknowledged of an Information Disclosure Statement, filed 27 May 2008, which has been placed of record in the file. An initialed, signed and dated copy of the PTO-1449 form is attached to this Office action.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by applicant's admitted prior art.

At pages 1 and 2 of the written description under the heading BACKGROUND ART and in figure 5 of the present application applicant admits that a driver structure is old and well known which has the same structural features as those set forth in claim 1.

In particular, the admitted prior art discloses a driver structure comprising a blade edge (20); a first pair of projections (21), each projection (21) of the first pair being provided at an opposite end portion of the blade edge (as seen in fig. 5); a second pair of projections (25), each projection (25) of the second pair being provided on the blade edge (20) in vicinity of one the projections (21) of the first pair and each projection (25) of the second pair has a corner portion, a middle projection (above 24 in fig. 5) provided on the blade edge between the projections (25) of the second pair, each projection (21) of the first pair has a guiding surface, the middle projection (above 24 in fig. 5) comprises a crown pressing portion.

The structural limitations of claim 1 are met by the admitted prior art, and the recitations “disposed to be in contact with the staple”, “disposed to be in contact with a corner formed between the crown and one of the leg portions for pressing the leg portion perpendicularly while retaining opposite ends of the crown inwardly when the leg portion passes through the bundle of papers”, “configured to be in contact with the crown in vicinity of one of the leg portions when the leg portion passes through the bundle of papers”, “to hold the crown of the staple when the pair of leg portions pass through the bundle of papers”, “disposed adjacent to one of the comers of the staple, which engages with the crown and is configured to prevent the comer of the staple from slipping toward a central side of the crown”, “positioned at least partially outside of an outside edge of one of the leg portions, so as to guide said outside edge of the leg portion and restrict the broadening of a leading end of the leg portion when the leg portion of the staple through the bundle of papers” and “wherein the crown is held by

the first pair of projections, the second pair of projections and the crown pressing portion when stapling the bundle of papers” are functional and intended use statements which are fully capable of being performed by the admitted prior art structure shown in fig. 5 and described at pages 1 and 2 of the present application.

Response to Arguments

5. Applicant's arguments filed 22 May 2008 have been fully considered but they are not persuasive.

Applicant has amended the subject matter of claim 1 to additional functional recitations (“while retaining opposite ends of the crown inwardly” and “wherein the crown is held by the first pair of projections, the second pair of projections and the crown pressing portion when stapling the bundle of papers”) and argued that the admitted prior art shown in figure 5 does not disclose all of the claimed features.

As was stated in the previous Office action, dated 25 January 2008, the admitted prior art, as also discussed above, does disclose all of the structural limitations found in claim 1. The driver structure shown in fig. 5 of the present application includes the first projections, the second projections, and the middle projection because a comparison of figure 3 showing an embodiment of applicant's claimed invention and figure 5 showing the prior art reveals that the two are virtually identical in structure, and most importantly both have identical middle projections. The driver structure of figure 5 is fully capable of performing the functional recitations in claim 1. A review of applicant's arguments and written description describes the claimed middle projection as corresponding to crown pressing portion or third projecting part 9 in figure 1, and as crown pressing portion or

third projecting part 10 in figure 2. This is what applicant has argued, but it is also noted that the claimed middle projection also corresponds to crown pressing portion or third projecting part 10 in figure 3. The structural limitations found in claim 1 are anticipated as the identical structure is disclosed by that which is described in the specification at pages 1 and 2 and shown in figure 5.

Applicant's argument that the amendment to claim 1 to recite the added term "...while retaining opposite ends of the crown inwardly..." and the added term "...wherein the crown is held by the first pair of projections, the second pair of projections and the crown pressing portion when stapling the bundle of papers" and the corresponding argument that "in the original specification, it was explained that the conventional driver structure yields the problems of having the leg portions being moved inwardly during the stapling of a bundle of papers, and having the crown curve to project in an arch from the bundle of papers. Spec. p. 2, lines 1 to 18. The invention as claimed resolves these problems, by including the features of the first projecting parts 7, 7, the second projecting parts 8, 8, and the crown-pressing portion 10 to hold the whole of the crown. The invention as claimed thus prevents these problems. FIG. 5 of the application, designated as prior art, does not disclose all of these claimed features, as was asserted by the examiner. This has been explained at length in prior responses, incorporated herein by reference. Attention is drawn in particular to the arguments on pages 5-6 of the Response to Office Action filed November 21, 2007."

As stated above in the rejection of claim 1, the admitted prior art shown as figure 5 of the present application does in fact meet all of the structural limitations set forth in

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the claim. As stated above, the language which applicant argues in the response is deemed to be functional and a statement of intended use. Furthermore, the language which applicant argues is also deemed a statement of a future act which may or may not occur. Accordingly, the type of language in claim 1, as set forth in the above rejection, is afforded no patentable weight as it fails to structurally distinguish the apparatus claim from the apparatus disclosed by the admitted prior art. The subject matter of claim 1 is directed to an apparatus, and it has long been held that an apparatus claim must structurally distinguish itself from the prior art in order to avoid anticipation under 35 USC 102. From MPEP § 2114,

"While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

Accordingly, the subject matter of claim 1 is properly rejected under 35 USC 102(b) as anticipated by the admitted prior art as the claim fails to recite any structural feature not already found in the admitted prior art.

Conclusion

6. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the

application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen F. Gerrity whose telephone number is 571-272-4460. The examiner can normally be reached on Monday - Friday from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen F. Gerrity/
Primary Examiner
Art Unit 3721

31 July 2008